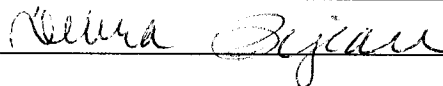
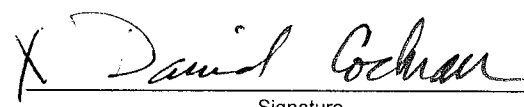
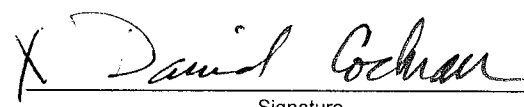
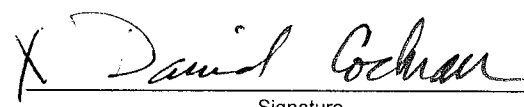


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 555255-012604							
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>02/26/2008</u> Signature <u></u> Typed or printed name <u>Debra Pejeau</u>	Application Number 10/687,139	Filed 10/16/2003							
	First Named Inventor Herbert A. Little								
	Art Unit 2132	Examiner Laurel L. Lashley							
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td rowspan="4"> Signature David B. Cochran Typed or printed name (216) 586-7029 Telephone number Feb. 26, 2008 Date</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>39,142</u></td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <table border="1"><tr><td><input type="checkbox"/> *Total of _____ forms are submitted.</td></tr></table>				<input type="checkbox"/> applicant/inventor.	 Signature David B. Cochran Typed or printed name (216) 586-7029 Telephone number Feb. 26, 2008 Date	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>39,142</u>	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<input type="checkbox"/> *Total of _____ forms are submitted.
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<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____									
<input type="checkbox"/> *Total of _____ forms are submitted.									

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 555255-012604

Group Art Unit:	2132)	
)	
Examiner:	Lashley, Laurel L.)	
)	
Inventor:	Little et al.)	
)	Pre-Appeal Request for Review
Serial No.:	10/687,139)	
)	
Filed:	October 16, 2003)	
)	
For:	System and Method of Security)	
	Function Activation . . .)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This pre-appeal request for review responds to the Final Office Action mailed on September 26, 2007 and the Advisory Action mailed on December 11, 2007. Any fees due for filing this paper should be charged to Jones Day Deposit Account No. 501432, ref: 555255-012604.

The final rejection of claims 1 and 12 as being obvious over Hocker (U.S. 5,930,368) in view of Muratov (U.S. 7,159,120) should be withdrawn because: (1) the references do not disclose the claimed subject matter; and (2) the final rejection fails to set forth any rationale to support the conclusion of obviousness, contrary to the Supreme Court's decision in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007) and MPEP § 2141. In addition, the final rejection of claims 16, 18, 20 and 21 should be withdrawn because the applicants have demonstrated that the rejection of these claims is clearly erroneous.

**I. The References Fail to Disclose Deleting Confidential Information
When the Mobile Device Is Stored in the Holder**

The Final Office Action relies primarily on Hocker in rejecting independent claims 1 and 12, but admits that it “*does not expressly teach wherein the one or more security functions include deleting confidential information from a memory of the mobile device.*” (Final Office Action at page 3). It is important to note that this admittedly-missing function from Hocker occurs in claims 1 and 12 of the present application when the mobile device is (has been) stored in the mobile device holder. In an attempt to make up for this missing teaching from Hocker, the Final Office Action turns to Muratov, which teaches that data may be erased from the memory of a portable device, but only in two very limited circumstances. First, Muratov teaches that data may be erased from the mobile device after a “predetermined limited number of [faulty] attempts”¹ to access the data are detected by the portable device, such as, for example, “after a predetermined number of non-valid passwords are entered that fail to match a valid password.” (Muratov, col. 2, ll. 56-57). And second, Muratov teaches that data may be erased “after a predetermined time period between syncing the PDA to another device.” (Muratov, col. 2, ll. 11-12).

Importantly, there is no suggestion in Muratov that data is erased when the mobile device is (has been) stored in the mobile device holder, as required by claims 1 and 12 of the present application. Instead, the two circumstances that trigger the erasure of data in Muratov would likely occur when the mobile device was not stored in the holder. In the first circumstance, the mobile device must be out of its holder because a person is interacting with the mobile device by entering the invalid passwords. In the second circumstance, the mobile device is also likely in its holder because in Muratov the only “synchronization” operation described is the HOTSUNC

¹ Muratov, col. 2, line 5.

operation, which at the time of Muratov's filing was typically accomplished by putting the PDA into a cradle that held the device. Thus, Muratov's second circumstance would likely happen only when the PDA was not in the cradle holding the device.

Thus, even in combination, the references do not teach that confidential data is deleted from the memory of the mobile device when the mobile device is stored in the mobile device holder, as required in claims 1 and 12 of the present application. Hocker, admittedly, does not disclose erasing confidential data from the mobile device memory under any conditions, and Muratov only discloses erasing data when the mobile device is not stored in the holder. The Advisory Action fails to address this important point regarding the timing of when the security function is activated, and appears to be ignoring this limitation of the claims by stating “[r]egardless of the condition for which Muratov teaches erasing memory, the reference reads on Applicant's invention.” As a consequence of this failure to demonstrate how the references disclose all of the claim limitations in claims 1 and 12, the obviousness rejection over Hocker in view of Muratov cannot stand.

II. The Final Office Action Lacks Any Rationale or Analysis for Combining the References

Even if the combination of Hocker and Muratov disclosed all of the elements and limitations of claims 1 and 12, the Final Office Action fails to articulate any reason or rationale for combining the references that is not based on hindsight reconstruction of the applicants' claims. At page 3 of the Final Office Action, the stated conclusion of obviousness based on the combination of Hocker and Muratov is justified by the single statement that “[t]he motivation for doing so would have been to provide additional security functions to maintain security of data/information stored on the mobile device.”

First, this statement doesn't make any technical sense at all. In Hocker an address identifier or an encryption key is automatically exchanged between a portable device and a selected intelligent device upon docking the portable device. (Hocker, col. 3, ll. 25-34) Once removed, the portable device can then use the encryption key to transfer encrypted data to the selected intelligent device. If this functionality were combined with Muratov, according to the Examiner, then there would be no reason to transfer data to the selected intelligent device because it would have been erased when the user of Hocker's device stored it into its holder. Thus, from a technical perspective, the combination of references doesn't make any sense. Muratov's erasure step would render Hocker's encryption process inoperable.

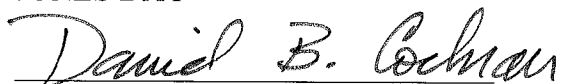
Second, this single statement is exactly the type of "mere conclusory statement" that the Supreme Court warned about in the *KSR* decision. In *KSR*, the Supreme Court stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*KSR*, 550 US ___, 82 USPQ2d at 1396). This principle has now been incorporated into MPEP § 2141, which says "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." Here, there is no "articulated reasoning" or "rational underpinning" to support the combination of Hocker and Muratov other than the mere conclusion that it would "provide additional security functions." Certainly this is insufficient justification to support the hindsight reconstruction of the applicants claims based on the selective teachings of these references – teachings which, as noted above, are technically incompatible with one another. For this additional reason the obviousness rejection of claims 1 and 12 cannot stand.

III. The Rejection of Claims 16, 18, 20 and 21 is Clearly Erroneous

In rejecting dependent claims 16 and 20, which add the limitation that the confidential information that is deleted from the memory of the mobile device is “a decrypted version of encrypted information,” the Final Office Action relies upon the Hocker reference. This must be mistake, however, because in rejecting the independent claims, the Final Office Action admitted that Hocker “*does not expressly teach wherein the one or more security functions include deleting confidential information from a memory of the mobile device.*” (Final Office Action at page 3). Thus, the Final Office Action’s reliance upon Hocker for a further limitation of something that is admittedly missing from Hocker appears to be in error. The Advisory Action is silent on this point. Thus, the rejection of claims 16 and 20 cannot stand.

The rejection of claims 18 and 21 must also be withdrawn. In rejecting these claims, which add the limitation that the one or more security functions “include closing a data item currently being displayed,” the Final Office Action admits that this limitation is missing from Hocker, but then erroneously relies upon Muratov. Specifically, the Final Office Action refers to column 2, ll. 36-38 and 53-57 of Muratov. These portions of Muratov, however, are silent with respect to “closing a data item currently being displayed.” Rather, these portions of Muratov discuss the concept of “locking” the portable device once a number of faulty data access attempts are detected. Here again, the Advisory Action makes no attempt to refute this point and thus the rejection of claims 18 and 21 cannot stand.

JONES DAY



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